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EXAMINER
GARG, YOGESH C

ART UNIT	PAPER NUMBER
3625	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/751,081	MOYER, MIKE
	Examiner	Art Unit
	Yogesh C Garg	3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _20 December 2000_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-20_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-20_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _2_ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-20 are rejected under 35 U.S.C. 101 because the claimed inventions are inoperative and therefore lacks utility. Exemplary claims 11 and 20 recite a computer program product and a system, respectively, having a plurality of elements, each in the form of computer codes and logic (for the intended functions of receiving a request, displaying the primary product, etc.) which are capable of interacting with each other but are not embedded in a structure. The system is rendered non-functional and inoperative because there is nothing in the claimed system to impart functionality to these computer codes. Note that functionality of the computer executable codes is realized only, when they are embedded in a structure and acted upon by a processor or a computing device. When claims are directed to disembodied data structure, such as claims 11 and 12, claims which are per se not statutory. C.f. In re Wamerdam.

The examiner suggests to redraft the claims to include a computer readable medium so that the claimed software in combination with a computer readable medium will be capable of producing a useful, concrete and tangible result. A claim to a computer readable medium encoded with functional descriptive material that can function with a computer to effect a practical application that results in a useful, concrete

an tangible result (i.e. running an assembly line or executing a stock transaction)

satisfies Section 101. See U.S. Patent 5,710,578 to Beauregard etc. These are merely

stored to be read or outputted by a computer without any functional interrelationship,

and thus do not impart functionality to the computer, i.e., they are not computer

components. **Examples of Non-Functional Descriptive Material: Music, Literature,**

Art, Photographs, Data base per se are directed to neither a "process" nor a

"machine," but rather embraces or overlaps two different statutory classes of invention

set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of

invention in the alternative only. Id. at 1551.

This deficiency is also present in each of the dependent claims 12-19.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-10, 11, 13-19, and 20 are rejected under 35 U.S.C. 102(e) as being

anticipated by Schachne et al. (US Pub. No: 2001/0042020 A1); hereinafter, referred to

as Schachne.

Regarding claim 1, Schachne teaches a computer-implemented method for

conducting business over a network utilizing a graphical user interface (see at least

abstract, and page 1, paragraphs 0005-0006), comprising the steps of:

(a) receiving a request indicating a primary product or service utilizing a

network (see at least FIG.3, " 72—*Request Product Info From Computer Site*", and page 2,

paragraphs 0018-0019 , " *FIG.3 shows a flow chart .... To initiate a business transaction over*

the network 18, the customer using the computer system 10 requests access to a web page of the seller

stored on the server system 14 (step 72). In response to this request, the server system 14 transmits the

requested web page to the computer system 10 (step 74).........". Note: In Schachne the step 72

of requesting product information via network 18 corresponds to the claimed limitation.

"The product" is Schachne corresponds to a primary product/service.).

(b) displaying the primary product or service on a graphical user interface utilizing

the network in response the request (see at least FIG.2, " 56" is the graphical image of a

business offering. Note: "business offering" in Schachne corresponds to the primary

product/service as claimed. Further, to display graphical image "56" a product/service

will inherently include a graphical user interface. Further, see page 2, paragraph 0016,

"..........*The order form can also include instructions 50 on filling out the form, a description 52 of each*

business offering being ordered, and a graphical image 56 of that business offering. ". Also see page

1, paragraph 0012 " *..Each Web page provides a graphical representation of text and images...*".) . ;

(c) displaying at least one secondary product or service associated with the

primary product or service utilizing the network in response the request (see at least

FIG.3, " 84—*Make An Offer To The Customer To Conduct A Second Different Transaction* ", and

page 2, paragraph 0022-page 3, paragraph 0023, " .... *an offer is presented to the customer*

to enter a second business transaction different from the previous business transaction (step 84). The

offer can be presented by a pop-up window on the screen 30 of the computer system 10 or by a new

display screen. ......[0023] Presenting this offer at the moment the customer intends to conclude the

previous business transaction generates one more opportunity for the seller to gain a sale from the

customer....... In one embodiment, the offer can involve subject matter that is related to subject matter of

the previous business transaction......... ". Note: In Schachne, the displaying of second

business transaction related to the first business transaction corresponds to displaying

one secondary product or service associated with the primary product/service.).; and

(d) allowing a user to select the at least one secondary product or service utilizing the

network (see at least FIG.4, " *118-Accept, 122-Reject* " and page 3, paragraph 0024, "*..FIG.*

4 shows an exemplary pop-up window 114 containing the offer 116 superimposed on the order form 48.

The offer 116 can include a graphical button 118 for accepting the offer and another graphical button 122

for rejecting the offer. In another embodiment, the offer 116 can be displayed on a new screen display. " .

Note: In Schachne, the step of allowing the user to accept an offer 116, which can be

either that is primary or secondary, corresponds to allowing a user to select at least one

secondary product or service as claimed. Also see page 3, paragraph 0025, which is

directed to the concluding of secondary product/service).

Regarding claim 3, Schachne teaches a computer-implemented method offering

a secondary product/service to a user over a network, as analyzed and disclosed in

claim 1 above. Schachne further discloses the step of linking to a check out interface in

response to the selection of a check out icon on the graphical user interface, wherein

the check out interface lists the primary product or service and any secondary product

or service selected by the user for purchasing purposes (see at least page 3,

paragraphs 0024-0026, "..... *The offer 116 can include a graphical button 118 for accepting the offer*

.... In another embodiment, the offer 116 can be displayed on a new screen display. [0025]

Referring again to FIG. 3, when the customer accepts the offer, this concludes the second business

transaction without requiring the customer to submit additional customer information or reply to any

queries or make any other selections or responses (step 88). .... [0026] Because this process requires

no further action from the customer to complete the proposed second business transaction, the relative

ease of conducting business transactions may entice the customer to accept the offer, and consequently

stimulates business. ". Note: In Schachne, "a graphical button 118 for accepting the offer"

corresponds to the check out button as claimed. By selection of this button the system

links to the check out interface so that the process requires no further action from the

customer to complete the purchase transaction for both primary and secondary

products/services selected by the consumer.).

Regarding claim 4, Schachne teaches a computer-implemented method offering

a secondary product/service to a user over a network, as analyzed and disclosed in

claim 1 above. Schachne further discloses the step of adding the primary product or

service and any secondary product or service selected by the user in response to the

selection of an add icon (see at least page 3, paragraphs 0024-0026, "..... *The offer 116*

can include a graphical button 118 for accepting the offer .... In another embodiment, the offer 116

can be displayed on a new screen display. [0025] Referring again to FIG. 3, when the customer accepts

the offer, this concludes the second business transaction without requiring the customer to submit

additional customer information or reply to any queries or make any other selections or responses (step

88). .... [0026] Because this process requires no further action from the customer to complete the

proposed second business transaction, the relative ease of conducting business transactions may entice

the customer to accept the offer, and consequently stimulates business. ". Note: In Schachne, "a

graphical button 118 for accepting the offer" corresponds to the add on button as

claimed. By selection of this button the system inherently adds the items selected,

which include both primary and secondary because after clicking this icon the process

requires no further action from the customer to complete the purchase transaction for

both primary and secondary products/services selected by the consumer.).

Regarding claim 5, Schachne teaches a computer-implemented method

offering a secondary product/service to a user over a network, as analyzed and

disclosed in claim 1 above. Schachne further discloses that the user is permitted to

select the at least one secondary product or service by selecting a check box (see at

least FIG.4, " *118-Accept, 122-Reject* " and page 3, paragraph 0024, "*..FIG. 4 shows an*

exemplary pop-up window 114 containing the offer 116 superimposed on the order form 48. The offer 116

can include a graphical button 118 for accepting the offer and another graphical button 122 for rejecting

the offer. In another embodiment, the offer 116 can be displayed on a new screen display. " . Note: In

Schachne, the step of allowing the user to accept a secondary offer 116 by pressing a

graphical button 118 for accepting the offer corresponds to selecting a check box as

claimed because in any case the box is to be clicked to indicate selection.).

Regarding claim 6, Schachne teaches a computer-implemented method

offering a secondary product/service to a user over a network, as analyzed and

disclosed above in claim 1. Schachne further discloses that the user is permitted to

deselect the at least one secondary product or service by selecting the check box again

(see at least FIG.4, " *118-Accept, 122-Reject* " and page 3, paragraph 0024, "*..FIG. 4 shows*

an exemplary pop-up window 114 containing the offer 116 superimposed on the order form 48. The offer

116 can include a graphical button 118 for accepting the offer and another graphical button 122 for

rejecting the offer. In another embodiment, the offer 116 can be displayed on a new screen display. " .

Note: In Schachne, the step of allowing the user to reject a secondary offer 116 by

pressing a graphical button 122 again for rejecting the offer corresponds to deselecting

the offer 116 for secondary product/service).

Regarding claim 7, Schachne teaches a computer-implemented method

offering a secondary product/service to a user over a network, as analyzed and

disclosed in claim 1 above . Schachne further discloses the step of linking to an

additional graphical user interface featuring the secondary products or services upon

the selection of an icon indicative of the secondary products or services (see at least

page 3, paragraph 0025, "......... *Referring again to FIG. 3, when the customer accepts the offer,*

this concludes the second business transaction .... If the offer originated from a server system other

than the server system 14, then the computer system 10 can communicate the acceptance of the

customer and the customer information with that other server system 16, directly or via the server

system 14, and that other server system 16 can use the customer information to conclude the second

business transaction. ". Note: It was already analyzed above that the user indicates his

acceptance of the offer for secondary products/services by selecting and clicking

graphical button 122 in claim 5 above. Here, in paragraph 0025, Schachne discloses that the acceptance of the offer for the secondary product/service is communicated to another server system 16 via existing server system 14 corresponds to linking to an additional graphical user interface featuring the secondary products/services on the other server 16.).

Regarding claim 8, Schachne teaches a computer-implemented method offering and displaying a secondary product/service related to a primary product/service to a user over a network, as analyzed and disclosed in claim 1 above. Schachne, further, shows that the step of displaying a plurality of additional primary products or services related to the primary products or services on the graphical user interface (see at least page 2, paragraph 0015, " *In this embodiment, the web pages stored on the server system 14 include a plurality of web pages designed by a business association that advertise business offerings (e.g., products and services) of the business association. Some of these web pages are designed to conduct business transactions so that potential customers using remote computer systems, such as the computer system 10, can access these web pages, browse the business offerings, and submit purchase orders across the network 18. A business transaction includes taking by sale, lease, premium, gift, or any other voluntary transaction between a potential customer and a business association that gives the customer an interest in a business offering of the business association.* ". Note: Here, Schachne discloses that the system offers a plurality of products/services for sale and therefore, keeping in view the teachings of claim 1, Schachne can display a plurality of additional primary products or services related to the primary products or services on the graphical user interface.).

Regarding claim 9, Schachne teaches a computer-implemented method

offering and displaying a plurality of additional primary products or services related to

the primary products or services on the graphical user interface as analyzed and

disclosed in claim 8 above. Schachne further suggests linking to an additional graphical

user interface featuring the additional primary products or services upon the selection of

an icon indicative of the additional primary products or services (see at least page 3,

paragraphs 0024-0025, " *FIG. 4 shows an exemplary pop-up window 114 containing the offer 116*

superimposed on the order form 48. The offer 116 can include a graphical button 118 for accepting the offer ...... In

another embodiment, the offer 116 can be displayed on a new screen display. [0025] Referring again to FIG. 3, when

the customer accepts the offer............ The computer system 10 signals the server system 14 of the acceptance,

and transmits the customer information, if not previously transmitted. .... If the offer originated from a server

system other than the server system 14, then the computer system 10 can communicate the acceptance of the

customer and the customer information with that other server system 16, directly or via the server system 14, and that

other server system 16 can use the customer information to conclude the second business transaction. ". Note:

In Schachne, accepting the offer by clicking the graphical button 118 corresponds to

selection of an icon indicative of the additional primary products/services and linking to

another server system 16 via existing server system 14 corresponds to linking to an

additional graphical user interface featuring the additional primary products or services.

The secondary business transaction, in Schachne, relates to additional primary

products/services , see at least paragraph page 3, paragraph 0023, "*In another*

embodiment, the subject matter of the offer can be unrelated to the subject matter of the previous

business transaction. A different business association than the business association of the previous

business transaction may be presenting the offer. ". When the offer for products/services is not

related to the earlier product then the offer constitutes for additional primary

products/services.).

Regarding claim 10, Schachne teaches a computer-implemented method

offering and displaying a secondary product/service related to a primary product/service

to a user over a network, as analyzed and disclosed in claim 1 above. Schachne,

further, shows that the secondary products or services are intended to be used with the

primary products or services (see at least page 3, paragraph 0023, *"........Presenting this

offer at the moment the customer intends to conclude the previous business transaction generates one

more opportunity for the seller to gain a sale from the customer, particularly if the offer brings to the

attention of the customer an item of potential or known interest that may have been overlooked. **In one

embodiment, the offer can involve subject matter that is related to subject matter of the previous

business transaction.** For example, if the previous business transaction is a purchase of a certain book,

then the second, different business transaction can be for the purchase of another book by the same

author or on the same topic....... ".* Note: In Schachne, the previous business transaction

corresponds to primary products/services and second, different business transaction

corresponds to the secondary products/services related to the primary

products/services. In the illustrated example Schachne, discloses that the secondary

offer for a book is also related to the same topic as the previous book and thus the user

using the previously purchased book will also use/consult/read the second book as it is

related to the same topic.).

Regarding claim 11, all the intended functions of the computer program product code are directed to the same functions as recited in the steps of method claim 1. Therefore, claim 11 is rejected as anticipated by Schachne on the basis of same rational as discussed for claim 1 above.

Regarding claims 13-19, all the intended functions of the computer program product codes are directed to the same functions as recited in the steps of method claims 3-9. Therefore, claims 13-19 are rejected as anticipated by Schachne on the basis of same rational as discussed for claims 3-9 above.

Regarding claim 20, all the intended functions of the claimed system are directed to the same functions as recited in the steps of method claim 1. Therefore, claim 20 is rejected as anticipated by Schachne on the basis of same rational as used for claim 1 above.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Schachne and in view of Sparks et al. (US Patent 6,167,382), hereinafter, referred

to as Sparks.

Regarding claim 2 , Schachne teaches a computer-implemented method

offering and displaying primary and secondary products/services to a user over a

network, as analyzed and disclosed in claim 1 above.

Schachne does not disclose the step of linking to a shopping cart interface in

response to the selection of a shopping cart icon on the graphical user interface,

wherein the shopping cart interface lists the primary product or service and any

secondary product or service selected by the user for reviewing the primary and

secondary products or services prior to purchase. However, in the field of same

endeavor, that is electronic commerce, Sparks teaches the step of linking to a shopping

cart interface in response to the selection of a shopping cart icon on the graphical user

interface, wherein the shopping cart interface lists the primary product or service and

any secondary product or service selected by the user for reviewing the primary and

secondary products or services prior to purchase (see at least FIG.3, " 80-cart" and

col.5, lines 48-49, " ..*placing retrieved images in a " shopping cart" for purchase, by clicking on button*

80 " . Note: In Sparks, clicking on button 80 corresponds to the step of linking to a

shopping cart icon in response to the selection of a shopping cart icon on the graphical

user interface as claimed. Further, placing the retrieved images in the " shopping cart"

for purchase corresponds to listing the purchased products, both primary and secondary before purchase, as claimed.).

In view of Sparks, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to have modified Schachne to incorporate the concept of Sparks of listing the purchased items in the shopping cart by clicking a shopping cart icon because it was well-known at the time of the applicant's invention to use shopping cart while buying products/services on-line to hold/list the purchased items just the same way a consumer does physically when making purchases in a departmental store and holding a physical cart before making the final check-out so that a person could add or delete some of the listed items before making a payment.

Regarding claim 12, all the intended functions of the computer program product codes are directed to the same functions as recited in the steps of method claim 2. Therefore, claim 12 is rejected as being unpatentable over Schachne and further in view of Sparks on the basis of same rational as discussed for claim 2 above.

Conclusion

4.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Patent 6,574,606 to Bell et al. discloses a method and a system for cross-marketing products/services to customers on the Internet (see at least abstract).

(ii) US Patent 6,629,079 B1 to Spiegel et al. and US Pub.No: 2002/0143637 A1 to Shmueli et al. disclose the sue of shopping carts in conducting purchases from merchant web sites on Internet.

(iii) US Patent 6,196,458 B1 to Walker et al. teaches offering upsell offers with the purchases of predetermined products (see at least abstract).

(iv) WO 00/67104 to Shupe et al. discloses an e-commerce method and system for conducting purchases from a merchants' web site using a shopping cart (see at least abstract).

(v) Songini, Marc L; " FedEx expects CRM system to deliver"; Computerworld. Framingham:Nov 6, 2000; Vol:34; Iss 45; pg.10, 1 pgs, extracted on Internet from http://proquest.umi.com on 12/11/2003 and Business/Technology Editors; " Essential.com to Patent New Internet Marketing System"; Business/Technology Editors: Business Wire: New York; Oct 5, 1999; Pg.1 extracted on Internet from http://proquest.umi.com on 12/11/2003 teaches cross-selling and upselling products on Internet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-308-

1113.

Yogesh C Garg
Examiner
Art Unit 3625

YCG
December 23, 2003